

ESTTA Tracking number: **ESTTA695471**

Filing date: **09/11/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	HSB Solomon Associates LLC
Granted to Date of previous extension	12/02/2015
Address	5400 LBJ Freeway Suite 1400 Dallas, TX 75240 UNITED STATES

Attorney information	George R. Schultz Schultz & Associates, P.C. 5400 LBJ Freeway Suite 1200 Dallas, TX 75240 UNITED STATES rschultz@grspc.com, nmarsh@grspc.com, docket@grspc.com, kneedham@grspc.com Phone:214-210-5940
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Applicant Information

Application No	86570055	Publication date	08/04/2015
Opposition Filing Date	09/11/2015	Opposition Period Ends	12/02/2015
Applicant	SOLUXE INC. 225 Main Street, Suite 301 Westport, CT 06880 UNITED STATES		

Goods/Services Affected by Opposition


Class 035. First Use: 2013/02/00 First Use In Commerce: 2013/02/00

All goods and services in the class are opposed, namely: Business consulting and advisory services in the field of energy efficiency; Business consulting services in the field of energy measurement to improve energy efficiency within residential, commercial, industrial and institutional facilities; Consultation in the field of energy efficiency; Consulting services in the field of energy efficiency for commercial and institutional facilities; Consulting services in the field of energy usage management and energy efficiency; Consulting services in the fields of energy consumption and usage conservation to improve energy efficiency; Energy usage management information services; Information in the field of energy efficiency; Providing consumer information in the field of energy efficiency solutions and saving on energy costs; Providing consumer information in the field of selection of energy generating products, energy efficiency products, and renewable energy products; Providing consumer product information for the purpose of selecting energy generating and energy efficiency products to meet the consumer's specifications; Providing recommendations of service providers to consumers for commercial purposes; Provision of information, advice and consultancy in relation to energy efficiency

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3428646	Application Date	05/23/2006
Registration Date	05/13/2008	Foreign Priority Date	NONE
Word Mark	SOLOMON PROFILE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2006/06/00 First Use In Commerce: 2006/06/00 Business performance evaluation services, namely, consultation service for the evaluation and monitoring of industry specific key performance indicators		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SOLOMON ASSOCIATES		
Goods/Services	business consulting services, namely, benchmarking analysis, production analysis, and forecasting analysis in the fields of chemical refineries, petroleum refineries, petroleum production, petroleum pipelines, petroleum transportation and petroleum storage and natural gas refineries, natural gas production, natural gas pipelines, natural gas transportation and natural gas storage, such services include analysis of energy consumption, energy improvements, and energy management optimization and recommendations for reduction of energy consumption and improvement of energy management and efficiency		

Attachments	78889799#TMSN.png(bytes) Notice of Opposition .0179 091115.pdf(399774 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/george r. schultz/
Name	George R. Schultz

Date	09/11/2015
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the matter of Trademark
Application Serial No.: 86/570,055**

For the mark: SOLOMON

Published in the Official Gazette on: August 4, 2015

HSB SOLOMON ASSOCIATES LLC

Opposer,

v.

OPPOSITION NO. _____

SOLUXE INC.

Applicant.

NOTICE OF OPPOSITION

HSB Solomon Associates LLC (“Opposer”) believes that it has been and will be damaged by registration of the mark shown in Application No. 86/570,055 (the “Application”), and therefore files this Notice of Opposition pursuant to 15 U.S.C. § 1063, and would respectfully show the Board the following:

I. Parties

1. Opposer is a Delaware limited liability company having a principal place of business at 5400 LBJ Freeway, Suite 1400, Dallas, Texas 75240.

2. Soluxe Inc. (“Applicant”) is a Delaware corporation having a principal place of business at 225 Main Street, Suite 301, Westport, Connecticut 06880. The correspondent of record for Applicant is Xavier Morales of Law Office of Xavier Morales, P.O. Box 6510, San Antonio, Texas 78209.

II. Standing

3. Opposer owns incontestable U.S. Registration No. 3,428,646 for the mark “SOLOMON PROFILE” for use in association with “business performance evaluation services, namely, consultation service for the evaluation and monitoring of industry specific key performance indicators” in international class 35. The mark was registered on May 13, 2008. The Registration is valid and subsisting. The date of first use cited in the Registration is June 2006. A copy of Registration No. 3,428,646 is attached as Exhibit A. A printout from the USPTO's TSDR database for Registration No. 3,428,646 is attached as Exhibit B.

4. Opposer owns longstanding common law rights in the mark “SOLOMON ASSOCIATES” for use in association with business consulting services, namely, benchmarking analysis, production analysis, and forecasting analysis in the fields of chemical refineries, petroleum refineries, petroleum production, petroleum pipelines, petroleum transportation and petroleum storage and natural gas refineries, natural gas production, natural gas pipelines, natural gas transportation and natural gas storage, such services include analysis of energy consumption, energy improvements, and energy management optimization and recommendations for reduction of energy consumption and improvement of energy management and efficiency. The date of first use of the mark “SOLOMON ASSOCIATES” by Opposer is at least as early as January 1981.

5. The mark shown in Registration No. 3,428,646 and the mark “SOLOMON ASSOCIATES” are hereinafter collectively referred to as “Opposer’s Marks.” The services listed in Opposer’s Registration No. 3,428,646 and rendered by Opposer under the mark “SOLOMON ASSOCIATES” are hereinafter collectively referred to as “Opposer’s Services.”

6. Since long before the date of filing of the Application, Opposer adopted and used Opposer's Marks in association with Opposer's Services. Opposer has continuously offered its services under Opposer's Marks since the adoption of each.

7. Opposer has expended substantial amounts of money, time, and effort in advertising and promoting Opposer's Marks across the United States. The trade and purchasing public have come to know and recognize Opposer's Marks and the associated services as being those of Opposer. Opposer's Marks identify Opposer as a source of Opposer's Services and distinguishes them from the services of many others.

8. Opposer's Marks are inherently distinctive or have acquired secondary meaning. Opposer's Marks have been used in a way that creates in the minds of the relevant purchasing public an association between Opposer's Marks and Opposer's Services.

9. Opposer's Marks have been used by Opposer to such an extent that the relevant purchasing public has come to associate Opposer's Marks as indicators of a source of origin for Opposer's Services.

10. By virtue of the excellent quality of the services offered by Opposer under Opposer's Marks, Opposer has become well known and has acquired an excellent and widespread reputation and extensive goodwill. Opposer's Marks are symbolic of the reputation and goodwill of Opposer and is of great and increasing value.

11. On information and belief, Applicant has adopted the mark "SOLOMON" ("Applicant's Mark") for use in association with "business consulting and advisory services in the field of energy efficiency; business consulting services in the fields of energy measurement to improve energy efficiency within residential, commercial, industrial and institutional facilities; consultation in the field of energy efficiency; consulting services in the field of energy efficiency

for commercial and institutional facilities; consulting services in the field of energy usage management and energy efficiency; consulting services in the fields of energy consumption and usage conservation to improve energy efficiency; energy usage management information services; information in the field of energy efficiency; providing consumer information in the field of energy efficiency solutions and saving on energy costs; providing consumer information in the field of selection of energy generating products, energy efficiency products, and renewable energy products; providing consumer product information for the purpose of selecting energy generating and energy efficiency products to meet the consumer's specifications; providing recommendations of service providers to consumers for commercial purposes; provision of information, advice and consultancy in relation to energy efficiency” in international class 35 (“Applicant’s Services”).

12. On March 19, 2015, an application to register Applicant’s Mark was filed under Section 1(a). The date of first use stated in the Application is February 2013. The date of first use in commerce stated in the Application is February 2013. The Application was published on August 4, 2015.

13. On August 26, 2015, Opposer requested a ninety (90) day extension of time, or until December 2, 2015, to oppose registration of Applicant’s Mark. Opposer’s request was granted on August 26, 2015.

14. Opposer’s Services are highly related to Applicant’s Services. On information and belief, Applicant’s Services are intended to be provided to similar consumers, under similar or identical advertising and move in the same channels of trade as Opposer’s Services.

15. Opposer’s Marks and Applicant’s Mark are substantially similar, both visually and phonetically, and create the same commercial impression.

III. Grounds

Likelihood of Confusion 15 U.S.C. § 1052(d)

16. Under § 2(d) of the Act, 15 U.S.C. § 1052(d), Applicant's Mark so resembles Opposer's "SOLOMON PROFILE" mark, previously used in the United States and registered with the USPTO by Opposer and not abandoned, as to be likely, when used on or in connection with Applicant's Services, to cause confusion, to cause mistake or to deceive.

17. Applicant's Mark is confusingly similar to Opposer's "SOLOMON PROFILE" mark. The similarity in sight, sound, and appearance between Opposer's "SOLOMON PROFILE" mark and Applicant's Mark creates a similar or identical commercial impression.

18. Applicant's Services overlap Opposer's Services at least to the extent that both include consulting and advisory services in relation to energy measurement and improving energy efficiency.

Likelihood of Confusion 15 U.S.C. § 1052(d)

19. Opposer incorporates herein the allegations set forth in Paragraphs 1 through 18 above.

20. Under § 2(d) of the Act, 15 U.S.C. § 1052(d), Applicant's Mark so resembles Opposer's "SOLOMON ASSOCIATES" mark, previously used in the United States by Opposer and not abandoned, as to be likely, when used on or in connection with Applicant's Services, to cause confusion, to cause mistake or to deceive.

21. Applicant's Mark is confusingly similar to Opposer's "SOLOMON ASSOCIATES" mark. The similarity in sight, sound, and appearance between Opposer's "SOLOMON ASSOCIATES" mark and Applicant's Mark creates a similar or identical commercial impression.

22. Applicant's Services overlap Opposer's Services at least to the extent that both include business consulting services in relation to energy measurement and improving energy efficiency.

IV. Damage

23. Opposer has superior rights in Opposer's Marks as compared to those of Applicant since Opposer has used Opposer's Marks in commerce continuously and prior to the filing of the Application by Applicant and prior to Applicant's date of first use. Consequently, confusion, mistake or deception in the trade and in the minds of the consuming public between Opposer and Applicant as to the origin of Applicant's Services is likely to occur and be exacerbated with resulting damage to Opposer if the mark in the Application is allowed to be registered.

V. Fees

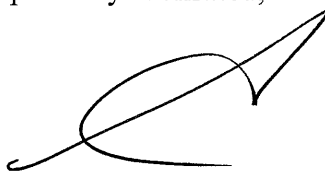
24. Pursuant to 37 C.F.R. § 2.6(a)(17), the required fee of Three Hundred Dollars (\$300.00) has been electronically paid in conjunction with the electronic filing of this Notice.

25. The Board is authorized to charge additional required amounts or issue any credits for overpayments to Deposit Account No. 50-2225.

WHEREFORE, Opposer prays that registration of the mark as shown in Application No. 86/570,055 be denied.

Dated: September 11, 2015.

Respectfully submitted,



George R. Schultz
Texas Bar No. 17837500
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Nicole R. Marsh
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nmarsh@grspc.com

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214-210-5941 facsimile


ATTORNEYS FOR OPPOSER
HSB SOLOMON ASSOCIATES LLC

CERTIFICATE OF SERVICE

A true and correct copy of the foregoing Notice of Opposition was served upon the persons listed below in the manner indicated on September 11, 2015:

Mr. Xavier Morales
Law Office of Xavier Morales
P.O. Box. 6510
San Antonio, TX 78209

Via First Class Mail, Postage Prepaid

A handwritten signature in black ink, appearing to be 'George R. Schultz', written over a horizontal line.

George R. Schultz

Exhibit A

Int. Cl.: 35

Prior U.S. Cls.: 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 3,428,646

Registered May 13, 2008

**SERVICE MARK
PRINCIPAL REGISTER**

SOLOMON PROFILE

HSB SOLOMON ASSOCIATES, LLC (DELAWARE
LTD LIAB CO)
SUITE 1500
13455 NOEL ROAD
DALLAS, TX 75240

FOR: BUSINESS PERFORMANCE EVALUATION
SERVICES, NAMELY, CONSULTATION SERVICE
FOR THE EVALUATION AND MONITORING OF
INDUSTRY SPECIFIC KEY PERFORMANCE INDICATORS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 6-0-2006; IN COMMERCE 6-0-2006.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,013,098 AND 2,061,205.

SN 78-889,799, FILED 5-23-2006.

JULIE WATSON, EXAMINING ATTORNEY

Exhibit B

**United States Patent and Trademark Office**

An Agency of the Department of Commerce

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SEARCH

MULTI-SEARCH [?](#)

US Registration No

3428646

Status

Documents

Status results found

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Generated on: This page was generated by TSDR on 2015-08-27 17:01:09 EDT**Mark:** SOLOMON PROFILE**SOLOMON PROFILE****US Serial Number:** 78889799**Application Filing Date:** May 23, 2006**US Registration Number:** 3428646**Registration Date:** May 13, 2008**Register:** Principal**Mark Type:** Service Mark**Status:** A Sections 8 and 15 combined declaration has been accepted and acknowledged.**Status Date:** Feb. 28, 2014**Publication Date:** Dec. 12, 2006**Notice of Allowance Date:** Mar. 06, 2007**▼ Mark Information**[▲ Collapse All](#)**Mark Literal Elements:** SOLOMON PROFILE**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK**▼ Related Properties Information****Claimed Ownership of US** [2013098](#), [2061205](#)**Registrations:****▼ Goods and Services****Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Business performance evaluation services, namely, consultation service for the evaluation and monitoring of industry specific key performance indicators**International Class(es):** 035 - Primary Class**U.S Class(es):** 100, 101, 102**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** Jun. 2006**Use in Commerce:** Jun. 2006**▼ Basis Information (Case Level)****Filed Use:** No**Currently Use:** Yes**Amended Use:** No**Filed ITU:** Yes**Currently ITU:** No**Amended ITU:** No**Filed 44D:** No**Currently 44D:** No**Amended 44D:** No**Filed 44E:** No**Currently 44E:** No**Amended 44E:** No**Filed 66A:** No**Currently 66A:** No

Filed No Basis: No

Currently No Basis: No

▼ **Current Owner(s) Information****Owner Name:** HSB Solomon Associates, LLC**Owner Address:** Suite 1400
5400 LBJ Freeway
Dallas, TEXAS 75240
UNITED STATES**Legal Entity Type:** LIMITED LIABILITY COMPANY**State or Country Where
Organized:** DELAWARE▼ **Attorney/Correspondence Information****Attorney of Record****Attorney Name:** George R. Schultz**Docket Number:** 75863.0112**Correspondent****Correspondent
Name/Address:** George R. Schultz
Schultz & Associates, P.C.
5400 LBJ Freeway
Suite 1200
Dallas, TEXAS 75240
UNITED STATES**Phone:** 214-210-5940**Fax:** 214-210-5941**Domestic Representative - Not Found**▼ **Prosecution History**

Date	Description	Proceeding Number
Jul. 24, 2014	ATTORNEY REVOKED AND/OR APPOINTED	
Jul. 24, 2014	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Feb. 28, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Feb. 28, 2014	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	68335
Feb. 12, 2014	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	68335
Feb. 28, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Feb. 12, 2014	TEAS SECTION 8 & 15 RECEIVED	
Apr. 13, 2010	ATTORNEY REVOKED AND/OR APPOINTED	
Apr. 13, 2010	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
May 13, 2008	REGISTERED-PRINCIPAL REGISTER	
Apr. 07, 2008	LAW OFFICE REGISTRATION REVIEW COMPLETED	76537
Apr. 04, 2008	ASSIGNED TO LIE	76537
Mar. 25, 2008	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Mar. 21, 2008	STATEMENT OF USE PROCESSING COMPLETE	70565
Mar. 21, 2008	EXTENSION 2 GRANTED	70565
Mar. 05, 2008	USE AMENDMENT FILED	70565
Mar. 05, 2008	EXTENSION 2 FILED	70565
Mar. 05, 2008	TEAS EXTENSION RECEIVED	
Mar. 05, 2008	TEAS STATEMENT OF USE RECEIVED	
Sep. 17, 2007	EXTENSION 1 GRANTED	65362
Aug. 10, 2007	EXTENSION 1 FILED	65362
Aug. 10, 2007	FAX RECEIVED	
Jul. 18, 2007	ATTORNEY REVOKED AND/OR APPOINTED	
Jul. 18, 2007	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Mar. 06, 2007	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Dec. 12, 2006	PUBLISHED FOR OPPOSITION	

Nov. 22, 2006	NOTICE OF PUBLICATION	
Nov. 01, 2006	LAW OFFICE PUBLICATION REVIEW COMPLETED	67287
Oct. 27, 2006	ASSIGNED TO LIE	67287
Oct. 23, 2006	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 23, 2006	ASSIGNED TO EXAMINER	76144
May 30, 2006	NEW APPLICATION ENTERED IN TRAM	
▼ Maintenance Filings or Post Registration Information		
Affidavit of Continued Use: Section 8 - Accepted		
Affidavit of Incontestability: Section 15 - Accepted		
▼ TM Staff and Location Information		
TM Staff Information - None		
File Location		
Current Location:	TMEG LAW OFFICE 109	Date in Location: Feb. 28, 2014
▼ Assignment Abstract Of Title Information - Click to Load		
▼ Proceedings - Click to Load		

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